

REMARKS/ARGUMENTS

Claims 1-62 are pending in the captioned application. Claims 57-62 have been withdrawn as drawn to a non-elected invention, while claims 1-56 stand rejected. Applicants hereby cancel the non-elected claims 57-62 without prejudice to the prosecution of these claims in one or more divisional applications. Applicants have amended claims 1 and 32. Applicants have also amended claim 50 to correct a typographical error. Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

Claims 1-31 stand rejected under 35 U.S.C. §112, first paragraph, for allegedly containing new matter. Applicants respectfully disagree.

The Examiner states that the recitation “with a phosphatase activatable label” is new matter. The Examiner further states that the specification does not provide basis for the concept of a phosphatase activatable label. The Examiner states that the basis Applicants relied upon (i.e., page 19, lines 12-13) teaches the label is activated after phosphatase treatment but does not teach the label is activated as a result of treatment with a phosphatase. Applicants respectfully disagree. Applicants submit that the specification provides support of “a phosphatase activatable label”. Applicants submit that further support can be found on page 11, lines 14-23, as well as the reaction scheme

immediately following that paragraph. Also see page 28, lines 9-20, as well as Examples 6-8.

The Examiner also alleges that there is no basis for the recitation “wherein said detectable species is readily distinguishable from the labeled polyphosphate or the terminal-phosphate-labeled nucleoside polyphosphate”. Applicants respectfully disagree. Applicants again assert that support can be found on page 4, lines 6-9; page 12, lines 20-23; page 19, lines 12-22 and Table 1. However, in light of further amendments to claim 1 (see response to the 102(b) rejection below), Applicants hereby remove this language. Applicants submit that the new matter rejections are now moot.

Claim 50 has been objected to for the recitation of “bodipy dyeand derivatives”. In response, Applicants have amended the claim to read “bodipy dye and derivatives”. Applicants submit that this is a simple typographical error and the amendment readily corrects it. Applicants submit that no new matter is introduced by this amendment.

Claims 1-7, 9, 11-18, 20-23, 27-38, 40, 42-45, 47, 49-50, 55 and 56 stand rejected under 35 U.S.C. §102 (b) as being anticipated by Williams et al (WO/2001/94609). Applicants respectfully disagree.

The Examiner states that that certain features of Applicants' invention are not recited in the claims. In response, Applicants have amended the claims to include these features. Specifically, claims 1 and 32 are amended to state that the terminal-phosphate labeled nucleoside polyphosphate is substantially non-reactive to phosphatase. Support for these amendments can be found in the specification, on page 3, lines 17-31 (especially lines 25-28). The Examiner states that the claimed methods use comprising language therefore do not exclude the method of Williams which requires separation by charge of the dye labeled pyrophosphate product. In response, the claims are amended to state that the detection step is performed without separation by charge of the polyphosphate (claim 32) or detectable species (claim 1). Applicants submit that the rejection of claims 1 and 32 over Williams is now moot.

The 35 U.S.C. §102 (b) rejection of claims 1-7, 9, 11-18, 20-23, 27-38, 40, 42-45, 47, 49-50, 55 and 56 should now be withdrawn.

Claims 8 and 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Wittwer et al (USPN 6,174,670). Claims 10 and 41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Keller et al (USPN 5,656,462). Claims 19 and 46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Lichenwalter et al (USPN 5,683,875). Claims 23-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over

Williams in view of Hattori et al (USPN 5,821,095). Claims 25 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Bronstein et al (USPN 5,112,960). These rejections are respectfully traversed. As stated above, Williams et al. does not disclose or even suggest independent claims 1 and 32, upon which these claims depend. In view of this, Applicants submit that the 35 U.S.C. §103(a) rejections should also be withdrawn.


Applicants respectfully assert that the claims are in allowable form and earnestly solicit the allowance of claims 1-56.

Early and favorable consideration is respectfully requested.

Respectfully submitted,

GE Healthcare Bio-Sciences Corp.

By: _____


Yonggang Ji
Reg. No.: 53,073
Agent for Applicants

GE Healthcare Bio-Sciences Corp.
800 Centennial Avenue
P. O. Box 1327
Piscataway, New Jersey 08855-1327

Tel: (732) 980-2875
Fax: (732) 457-8463

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Signature: _____

Name: _____

Melissa Leck